

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/671,736

Atty Docket No.: Q77754

REMARKS

The Office Action of April 28, 2005, has been received and its contents carefully considered.

Claims 1-19 are all the claims pending in the application, prior to the present amendment.

Claims 1-19 have been rejected under the first paragraph of 35 U.S.C. § 112 as being based on a specification which is non-enabling for the claimed subject matter.

The Examiner argues that the specification only provides enablement for a black ink that contains a dye of formula (1) that has the claimed properties, but does not provide enablement for all dyes that have the claimed properties. The Examiner states that the present claims encompass all dyes that have the claimed properties, but that the specification only discloses that the dyes of formula (1) have these properties.

The Examiner suggests that claim 12 be incorporated into each of claims 1 to 4.

In response, applicants have amended claims 1 to 4 to recite that the dye having a λ_{\max} of 500 to 700 nm is a dye represented by formula (1) and to further recite that in this dye, n is 1 or 2 and two or more of A, B and C is a substituted or unsubstituted, unsaturated heterocyclic group.

Support for this amendment can be found at page 17, lines 10 to 13 of the specification.

In view of the above, applicants submit that the claims comply with the requirements of the first paragraph of 35 U.S.C. § 112 and, accordingly, request withdrawal of this rejection

Claims 1, 3 and 6-17 have been rejected under the second paragraph of 35 U.S.C. § 112, as indefinite.

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The Examiner sets forth two reasons for this rejection. Applicants discuss each reason below.

(a) With respect to claims 1, 3, 6, 8 and 10, the Examiner states that the phrase “JIS code 2223” is indefinite.

“JIS code 2223” refers a Japanese Industrial Standard and is a code corresponding to the character “■” (a black square). This code appears in a list of JIS X0208 Kanji Codes for Information Exchange.

Applicants enclose a copy of this list as well as an English translation of this list. See the third page of the list and page 5 of the translation for JIS code 2223. The list is described in many websites. See, for example, <http://koba.jp/network/mail/JIS-X-0208.html>. The list at the above website is the same as the enclosed list. A copy of the printout from this website is attached. See page 5 of the printout for JIS code 2223.

(b) The Examiner states that claim 14 is indefinite because the phrase “which comprises a dye of the formula (1)” is confusing because it is unclear as to which dye in claim 2 is a dye of formula (1).

The Examiner states that she assumed the first dye in claim 2 is a dye of formula (1), and examined claim 2 based on this assumption.

As noted above, applicants have amended claim 2 to state that the first dye is a dye of formula (1), with the first dye being limited as set forth in claim 2.

In addition, applicants have amended claim 14 to state that the dye of formula (1) in claim 14 is the second dye having a λ_{max} of 350 to 500 nm.

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In addition, applicants have amended claims 12, 16 and 18 to recite a second dye of formula (1).

In view of the above, applicants request withdrawal of this rejection

The Examiner sets forth six double patenting rejections over claims of six co-pending patent applications owned by Fuji Photo Film Co., Ltd. The six copending applications are: Application No. 10/809,550, Application No. 10/714,945, Application No. 10/808,464, Application No. 10/671,729, Application No. 10/806,453 and Application No. 10/645,797.

In response to the double patenting rejections, applicants enclose a Submission of Terminal Disclaimer together with a signed Terminal Disclaimer which refers to each of the cited co-pending applications and the appropriate fee.

In view of the submission of the Terminal Disclaimer, applicants request withdrawal of each of the six double patenting rejections.

Claims 1, 3-7, 10-13 and 16-18 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by EP 0422668. EP'668 is relied upon as teaching a recording liquid comprising a solvent and at least one dye of the formula shown in the Office Action.

The Examiner further relies upon EP '668 as teaching that the dye is filtered several times before the final recording liquid is prepared and alleges that the composition of EP'668 is the same composition as the ink as claimed by applicants. On these bases, the Examiner asserts that the limitation of a "transition metal ion content of 0.1 mmol/l or less" is inherently disclosed

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in EP '668 and accordingly, that the black ink as taught by EP '668 anticipates the present claims.

In response, applicants submit that the specific examples of EP '668 cited by the Examiner on page 8 of the Office Action do not teach specific procedures for filtering to obtain a composition having the claimed transition metal ion content of 0.1 mmol/l or less.

EP '668 teaches filtering in a general manner and does not recite steps necessary for obtaining any specific transition metal ion content. Thus, for example, EP '668 does not teach or suggest specific procedures such as those set forth by applicants at pages 59-60 and at pages 107-108 of the present specification for obtaining the claimed transition metal ion content.

The dye of EP '668 is filtered in the synthesis step, and the ink of EP '668 is filtered through a Teflon filter in the preparation step, as shown in the Examples of EP '668. However, it is not possible to remove the cations of the present invention, which include magnesium ion, zinc ion, calcium ion, strontium ion, aluminum ion and transition metal ion, by the filtering disclosed in EP '668.

In addition, EP '668 does not disclose or suggest the dye of formula (1) as forth in claims 1, 3 and 4.

In view of the above, applicants submit that EP '668 does not disclose or render obvious the subject matter of the present claims and, accordingly, request withdrawal of this rejection.

Claims 1-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Taguchi et al (US 2004/0053988). This document corresponds to the co-pending application 10/645,797 that the Examiner employed in the double patenting rejection.

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The Taguchi et al '988 publication was published on March 18, 2004, and was filed in the United States on August 22, 2003, which is after the filing date of applicants' Japanese priority application JP 2002-286179, which was filed in Japan on September 30, 2002. Applicants enclose herewith a verified translation of applicants' Japanese priority document. As can be seen from the translation, the priority document supports all of the recitations of the present claims.

In view of the above, applicants request withdrawal of this rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

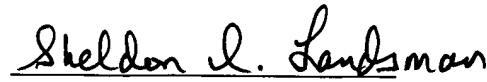
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